

### **REMARKS/ARGUMENTS**

In view of the amendments made to the claims, and in view of the following remarks, reconsideration of the application is respectfully requested.

Initially, the Applicant would like to thank the Examiner for withdrawing the previous rejections presented in this case after considering the Appeal Brief filed in this application on June 30, 2003. In addition, the Applicant would like to thank the Examiner for now indicating various claims to contain allowable subject matter, particularly claims 3, 4, 8, 10, 17-20 and 24. However, the Examiner has established a new rejection of claims 1-13, 14-27 and 29 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 2, 9 and 12 as being anticipated by Weissman (U.S. Patent No. 6,135,253); presented a new rejection of claims 1, 5-7, 11-13 and 15 based on Kirkland (U.S. Patent No. 6,006,945) in view of Elmaleh (U.S. Patent No. 5,692,606) in further view of Eimer (U.S. Patent No. 2,936,101); and further added U.S. Patent No. 4,981,229 of Lanham to the above 3-reference combination to further reject claims 9, 16, 21-23, 25-27 and 29. Below, each of these rejections are specifically addressed.

Initially, with respect to the § 112, second paragraph rejection, it is believed to be a typographical error in indicating that claim 14 was grouped with the rejected claims. Claim 14 has been canceled in this application. Regardless, the Examiner's rejection pertains to a limitation set forth in each of independent claims 1 and 16 concerning the density. The Examiner questions how a "density" can be compressed. It is respectfully submitted that claims 1 and 16 accurately define the invention. That is, these claims specify that the garment has a loose, uncompressed density. It is presumed that the Examiner has no potential questions of indefiniteness with this simple statement. The density of the garment is the ratio of its mass to its volume. When the garment is in a loose, uncompressed condition, it has a certain volume. However, when the garment is compressed, the mass of the garment remains the same and the volume is reduced. Therefore, the ratio of the mass of the garment to its volume is changed. In particular, in

accordance with the claimed invention, the garment is compressed to multiple times its loose, uncompressed density. When considered in this light, it is respectfully submitted that there is no indefiniteness in this claim subject matter for the same reason this rejection has not been presented in the various other Office Actions presented in this case, nor in issued Patent No. 5,692,606 cited herein relied upon by the Examiner which discusses compressing an article to a density of 2-12 times its associated uncompressed loose density. Therefore, withdrawal of this rejection is respectfully requested.

By the present amendment, claim 18 has been placed in independent form so as to include all the limitations of claims 16 and 18. As no prior art has been applied against this claim, it is respectfully submitted that claims 18-20 should be in clear condition for allowance.

With respect to the rejection of the remaining claims in this application, the Applicant respectfully traverses each of the rejections for at least the following reasons. Section 5 of the Office Action sets forth the rejection of claims 1, 2, 9 and 12 based on the teachings in Weissman et al. Initially, it is respectfully submitted that there is no clear disclosure in Weissman et al. that garment 100 constitutes hosiery. Unless the Examiner can specifically point to some disclosure to this effect in the Weissman et al. patent, it is respectfully submitted that the rejection under 35 U.S.C. § 102(e) should be withdrawn. With respect to the possible use of Weissman in an obviousness-type rejection, it is unclear to the Applicant how the Examiner would apply the reference. For instance, is the Examiner taking the leap that each and every garment shown in Figure 2 at 100 would be constituted by hosiery? Assuming that even one piece of hosiery was inserted between the various garments in Weissman et al., it is unclear where the Examiner is taking the specific teaching from Weissman that the garment would be compressed to multiple times its uncompressed density. Again, the mass of the hosiery would not change and this limitation concerning the compression need not at all be met in Weissman et al. if, for example, a single pair of hosiery was simply laid flat and closed within the suitcase. Therefore, it is assumed that the garment would actually need to be balled up and then compressed. It is submitted that there is absolutely no basis to hold

that Weissman et al. teaches such an arrangement. It is certainly possible to arrange a pair of pantyhose amongst sweaters or other fluffy garments within the suitcase of Weissman et al., wherein closing the lid would significantly compress the other garments and not the hosiery. Without hindsight of the present invention, it is respectfully submitted there is no reason to situate the hosiery so that it would specifically be compressed in the manner set forth in accordance with the present invention.

When also formulating this rejection, it should be realized that element 29 in Weissman et al. constitutes a rigid plate. This is being correlated to the buffer material which, as at least specified in claim 12, constitutes a delicate material. This distinction is not at all addressed in the Office Action. With respect to the recited cover member, the Examiner identifies element 22 in Weissman et al. which is actually a liner. It is respectfully submitted that liner 22 is not at all analogous to cover member 43 in accordance with the present invention, particularly if the claims are not read in a vacuum but rather the invention is considered as a whole in light of the specification. With further reference to the cover member, claim 2 requires that the cover member include a plurality of openings. To address this claim limitation, the Examiner points to openings 56 in Weissman et al. However, the Examiner should note that openings 56 are not provided in member 22 in Weissman, but rather in rigid floor 54. Since the Examiner is relying upon liner 22 to constitute the requisite cover member, openings 56 are simply not in this member and therefore do not address the particular claim limitations. With respect to the reference to top portion 12 of suitcase 10 being equated to cap member 65, it is respectfully submitted that this is an unreasonable interpretation of the claim subject matter. Again, the Examiner cannot properly read the claims in a vacuum but must consider the invention as a whole in light of the specification. It is clearly understood what is meant by the cap member, as well as the overall compact container of the present invention, and it is respectfully submitted that the suitcase of Weissman et al. does not in any way, shape, form or fashion anticipate or render obvious this claim subject matter.

On the bottom of page 5, the Examiner appears to acknowledge that Weissman et al. does not really disclose a delicate material or, particularly, hosiery as claimed, but

indicates that it would be obvious to package hosiery in the suitcase of Weissman et al. First of all, simply because packaging hosiery is known that does not make it per se obvious to put the same in the device of Weissman. Regardless, there is simply no teaching in the art that would suggest placing hosiery in the Weissman et al. suitcase in a manner which would assure that the hosiery is compressed to multiple times a loose, uncompressed density thereof. If one was to package hosiery in the suitcase, it is presumed that maybe one or two pairs would be placed therein. Certainly, the package would not be used to carry thousands of pairs of hosiery. Simply folding the hosiery and placing the same in the suitcase of Weissman et al. and then closing the suitcase would not compress the pantyhose in the manner set forth in accordance with the present invention. To this end, it is a compact package that is being claimed. If the Examiner even considers the potential size of a pair of pantyhose and then recognizes that the pantyhose are compacted to multiple times the loose, uncompressed density thereof, this would give life and meaning to the compact nature of the packaging being claimed and the realization that the invention is not anticipated by or obvious in view of the suitcase to Weissman et al.

With respect to the 3-way combination rejection set forth for claims 1, 5-7, 11-13 and 15, the Applicant is certainly of the opinion that the Kirkland et al. patented arrangement is more relevant in that it at least discloses a container which can be used to carry hosiery. However, Kirkland does not at all suggest compressing pantyhose within the container body in a manner required by that in accordance with the present invention. To this end, the Examiner relies on the teachings in Elmaleh Patent No. 5,692,606 to limit the size of the Kirkland package. With respect to this portion of the rejection, it is respectfully submitted that the Examiner cannot properly pick and choose features from individual patents and combine them in order to simply meet the claim limitations. For instance, it is respectfully submitted that if one was to modify the Kirkland arrangement in order to compress pantyhose therein in accordance with the Elmaleh reference, then one would also look to the types of closure arrangements disclosed in Elmaleh in the combination. For instance, it is unclear based on the combined teachings of these references how one would compress a pair of pantyhose into the container of Kirkland

and then apply the cover of Kirkland without the pantyhose springing out. In accordance with Elmaleh, the pantyhose are first inserted into the container as shown in Figure 5, then compressed in the manner shown in Figure 6 and, while in a compressed state, the actuators start to close the upper seal as shown in Figure 7. This retains the pantyhose within the container. As Kirkland has no desire at all to compress any of the food or non-food items stored therein, the type of cover 14 can be readily employed. This type of cover is particularly suitable for use with containers made from aluminum, tin, steel and other alloys and metals as discussed in column 5, lines 1-4 of Kirkland. In any event, it is respectfully submitted that if one was to rely upon the teachings in Elmaleh to compress pantyhose within a package, it would also utilize the teachings therein regarding how to seal the package when such pantyhose are compressed therein. As such, this combination would lack at least the cover member, pull-tab and ring of these claims.

The Examiner goes further on to modify this combination in view of Eimer in order to employ a tissue wrapping in the container. Again, the Examiner cannot properly pick and choose features from references and combine them without showing a desirability and support from the references. To this end, it must be realized that Eimer is concerned with gift wrapping a package in a box wherein the paper wrapping is not separate and distinct from the boxes but which is "permanently attached to the container..." as specified in column 1. Therefore, in the overall combination, some type of tissue paper would have to be fixedly attached within the container of Kirkland and then some how wrapped around a pantyhose which is compressed therein after the compression, following which the container would have to be sealed from some type of cover member. Just because tissue wrapping for article packages is known in the art as exemplified by Eimer, that does not make it simply obvious to employ a tissue buffer in the combination of Kirkland and Elmaleh. It is respectfully submitted that the Examiner has made an untenable combination of the Kirkland, Elmaleh and Eimer references using hindsight and/or using the present application itself as a template. The Examiner has not viewed the invention as claimed as a whole, but instead has found bits and pieces of the claimed invention and, using hindsight, combined these bits and pieces in an attempt to meet the claimed subject matter. "Mere fact that prior art may be modified to reflect

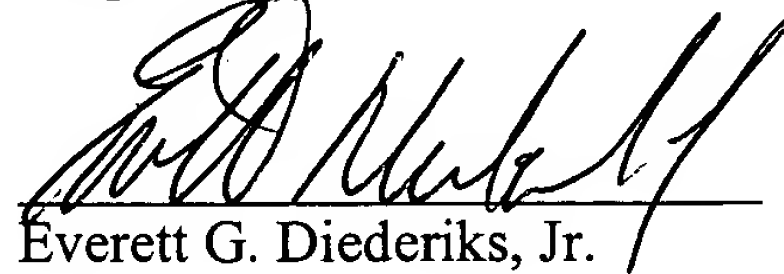
features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by prior art; claimed invention can not be used as an instruction manual or 'template' to piece together teachings of prior art so that claimed invention is rendered obvious." Fritch 23 USPQ 2<sup>nd</sup> 1780 (CAFC 1992). It is respectfully submitted that without the set of claims of the present invention in front of the Examiner and there being a specific attempt to combine the references to meet these claim limitations, one of ordinary skill would never modify Kirkland in view of Elmaleh and Eimer in a manner suggested by the Examiner.

The arguments set forth above are seen to also follow to the further modification of Kirkland in view of Elmaleh and Eimer in view of Lanham Patent No. 4,981,229. The Examiner here has stated it would be obvious to modify Kirkland in view of three additional references to meet specific claim limitations. The Lanham patent specifically talks about sealing types of products which require an oxygen moisture barrier film, such as coffee. Without hindsight of the present invention, one of ordinary skill in the art would not look to teachings in containers for coffee to modify a hosiery package, particularly since the seal in Lanham is employed to provide an oxygen moisture barrier. In the outstanding Office Action, the Examiner simply indicates that the combination is considered obvious in order to provide a cover for the package when the pull-tab cover is removed. Lanham provides a cover having a tab 15 which must be exposed, with the cover also extending around the upper edge of the container. It is unclear how one would provide such a lid in Kirkland as the pull-tab lid in Kirkland must also be provided at the uppermost edge. It is respectfully submitted that the upper edge is already taken by the pull-tab cover of Kirkland so that it would be impossible to mount the upper edge seal of Lanham in any case.



Based on the above remarks, and the amendments made to the claims, withdrawal of the rejections, allowance of the claims and passage of the application to issue is respectfully requested. If the Examiner should have any additional concerns regarding the allowance of this application, the Examiner is cordially invited to contact the undersigned at the number provided below to further expedite the prosecution.

Respectfully submitted,



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